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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/720,927 10/04/96 GIL

A PI/3C

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LM02/0621

EXAMINER
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COSIMANO, E

ART UNIT	PAPER NUMBER
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2761  
DATE MAILED:

06/21/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/720,927**

Applicant(s)

**Gil et al**

Examiner  
**EDWARD COSIMANO**

Group Art Unit  
**2761**



☒ Responsive to communication(s) filed on January 27, 1999 and May 17, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 4, 1996 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Feb 13, 1998 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.
2. The request filed on January 27, 1998 and May 17, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/720,927 is acceptable and a CPA has been established. An action on the CPA follows.
3. The disclosure is objected to because of the following informalities:

A) it is noted that the 109 pages of paper appendices as filed October 04, 1996 does not comply with the requirements of 37 CFR § 1.96(c). Note pages 1, 9, 15 & 34 which mention the appendices.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).
5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
- 5.1 Claims 1-19 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-3, 5, 7-9, 12, 16, 19-21, 24-26, 28-30 & 34 of prior U.S. Patent No. 5,481,464. This is a double patenting rejection.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- 6.1 Claims 5-12 & 16-19 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden (5,481,464).
7. It is noted that:

A) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the

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transmission of user data to a central location is the filing date of the instant application, that is August 02, 1994, while,

B) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location as copied from Ramsden ('464) is February 18, 1994.

Hence, the invention of claims 5-12 & 16-19 was known to others before the filing by applicant.

8. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8.1 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been overcome by applicant's last response.

9.2 As per the 35 U.S.C. § 101 statutory double patenting rejection, since:

A) 35 U.S.C. § 101 clearly permits one patent to be issued for an invention, regardless of the inventive entity or assignee, applicant's arguments are non-persuasive.

9.3 As per the 35 U.S.C. § 102(e) rejection, since:

A) the text referred to by applicant, (reproduced below):

"The customer is able to request an electronic mail operation (e.g., using

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a conventional electronic mail service such as MCI Mail) using one of the two types of floppy disc drives 124, 126 by inserting a floppy disk into the drive and following the voice/touch screen 110 instructions. The customer is thereby able to transmit his files to another computer. The cost of the electronic mail is deducted from the prepaid magnetic card and the card is returned to the customer.”

merely enables:

- (1) the insertion of a **PREPAID MAGNETIC CARD** containing a monetary value;
- (2) the loading of electronic mail data;
- (3) the transmitting of electronic mail data to a remote location;
- (4) the deduction of the cost of transmitting the electronic mail data from the monetary value stored in/on the inserted **PREPAID MAGNETIC CARD**; and
- (5) returning the inserted **PREPAID MAGNETIC CARD** to the owner of the card.

Therefore, it can not be seen how the above quoted text would enable one of ordinary skill to:

- (1) in regard claims 5-9, to either:
  - (a) use a credit card, (note also claim 8); or
  - (b) insert a credit card, which is different than a **PREPAID MAGNETIC CARD**, i.e. a debit card, because a credit card does not store a monetary value; or
  - (c) the transmit credit data to a remote location for billing the customer.

Since, payment in the 07/678,863 application is made at the “Automated Self-Service Package Shipping Machine” using a **PREPAID MAGNETIC CARD**.

- (2) in regard to claim 7 to:
  - (a) transmit shipping manifest data to a remote location.

Since, in the 07/678,863 application only the electronic mail data is transmitted and while the manifest data is stored at the “Automated Self-Service Package Shipping Machine”.

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(3) in regard claims 10-12 to either:

(a) transmit shipping fee data to a remote location for billing the customer; or

(b) use telephone lines to transmit the data.

Since, payment in the 07/678,863 application is made at the "Automated Self-Service Package Shipping Machine" using a **PREPAID MAGNETIC CARD**.

(4) in regard to claims 16-18 to:

(a) use a customer's account for billing the shipping fee.

Since, payment in the 07/678,863 application is made by using a **PREPAID MAGNETIC CARD** at the "Automated Self-Service Package Shipping Machine".

(5) in regard to claim 17 to:

(a) transmit shipping fee data to a remote location for billing the customer.

Since, payment in the 07/678,863 application is made at the "Automated Self-Service Package Shipping Machine" using a **PREPAID MAGNETIC CARD**.

(6) in regard to claims 9, 11 & 18 to:

(a) validate the credit card before issuing a shipping label for the customer.

Since, payment in the 07/678,863 application is made at the "Automated Self-Service Package Shipping Machine" using a **PREPAID MAGNETIC CARD**.

(7) in regard claim 19 to either:

(a) transmit shipping fee data to a remote location for billing the customer; or

(b) transmit shipping manifest data to a remote location; or

(c) use telephone lines to transmit the data.

Since,

(a) payment in the 07/678,863 application is made at the "Automated Self-Service Package Shipping Machine" using a **PREPAID**

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**MAGNETIC CARD**; and

(b) in the 07/678,863 application only the electronic mail data is transmitted and while the manifest data is stored at the "Automated Self-Service Package Shipping Machine".

Hence, applicant's argument's are non persuasive.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10.1 The fax phone number for **UNOFFICIAL FAXES** for this group is (703) 308-0040.

10.2 The fax phone number for **OFFICIAL FAXES** for this group is either (703) 308-9051 or (703) 308-9052.

06/11/99



**Edward R. Cosimano**  
**Primary Examiner A.U. 2761**